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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,951	10/24/2000	Eugenie Charriere	004900-188	8720

21839 7590 07/16/2003

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EXAMINER

SERGEANT, RABON A

ART UNIT PAPER NUMBER

1711

DATE MAILED: 07/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 09/673,951	Applicant(s) CHARRIERE ET AL.	
	Examiner Rabon Sergent	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 24-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Despite applicants' response, the term, "true trimer", has not been defined within the specification, and no evidence has been presented that one of ordinary skill would know that the term represents a product of the trimerization of only three monomers with no further propagation.

2. Claims 24-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the examiner has considered applicants' remarks concerning the definition of a "derived isocyanate function"; however, the position is maintained that the definition is repugnant to the art recognized definition. One of ordinary skill would not envisage the recited groups as falling within the definition of an isocyanate. Furthermore, applicants' language and its interpretation calls into question exactly what is encompassed by any of applicants' terms which include the term, isocyanate or polyisocyanate. By the set forth reasoning, it is unclear if any of applicants' tricondensate polyfunctional isocyanate compositions are required to contain any isocyanate groups? If applicants intend the language to mean other than isocyanate groups, then it is unclear why this language has not been used.

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Secondly, given that the definition of m is limited to no more than 1, it is unclear how n can have a value of 4. Applicants' response has not clarified this issue.

Lastly, despite applicants' response, the position is maintained that without specifying a weight or quantity relationship between the two steps of claim 40 or amounts of products within each of the two steps of claim 40, the claimed weight percent of claim 45 is essentially meaningless. There is no requirement that all of the product from step a) be used.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 46-50, 53, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 649866.

The reference discloses polyisocyanates containing isocyanurate groups and allophanate groups, wherein the allophanate group content reads on the contents claimed by applicants. See abstract.

5. Despite applicants' response, it is not seen that applicants' definition of their allophanate groups distinguishes them from the disclosed allophanate groups. Both are the reaction products of diisocyanates and alcohols.

6. Claims 53-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobs et al. ('482) or Potter et al. ('018).

Patentees disclose isocyanate compositions comprising monoisocyanurate groups and monoallophanate groups, wherein the weight ratio of monoallophanate to monoallophanate and monoisocyanurate is considered to meet that claimed within claim 53. Furthermore, since the references are directed to the production of monoallophanate groups, by carefully controlling the ratio of monoalcohol to diisocyanate, the position is taken that applicants' claimed low contents of bis- and tris-allophanates are inherently met by the references.

7. The examiner has considered applicants' remarks and the rejection has been modified, so as to more clearly set forth the rationale supporting the inherency position.

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8. Claims 24-45, 51, and 52 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Potter et al. ('018) or Jacobs et al. ('482) or EP 649866.

The references disclose the incorporation of allophanate groups into a trimerized polyisocyanate composition, so as to reduce the viscosity of the composition. See abstracts and columns 1 and 2 within Potter et al. and Jacobs et al.

9. Though the references are silent regarding the simple admixture of the allophanate component to the isocyanurate component, the position is taken that it is by no means certain that the claims as drafted exclude the process of adding the allophanate by forming it *in situ*. The claims simply require that the allophanate and trimerization products be combined. However, even if it is determined that the claims require the admixture of previously formed components, the position is taken that one would have expected that a decrease in viscosity would result from the simple admixture of the components, since it has long been known that the viscosity of a component can be reduced by adding a quantity of less viscous material.

10. The examiner has considered applicants' response; however, it is not seen that the argued examples are representative of the prior art or commensurate in scope with the claims.

11. Claims 24-26, 28-41, and 43-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woynar et al. ('359).

Patentees disclose polyisocyanate compositions comprising biurets, wherein it is particularly preferred to produce the biuret from hexamethylene diisocyanate. See abstract and

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column 2, lines 41 and 42. Patentees further teach at column 4, lines 64+ that allophanate groups may be incorporated within the composition, so as to modify the flexibility, bonding, hydrolysis resistance, hardness, and/or solvent resistance of the biuret polyisocyanates and the products produced from them. Therefore, the position is taken that it would have been obvious to incorporate a quantity of allophanate groups into a hexamethylene diisocyanate biuret composition, so as to obtain a biuret containing composition having the aforementioned improvements.

12. Applicants' arguments are not fully understood, in that it appears that applicants are arguing that the reference is not relevant since it fails to be concerned with isocyanurates. However, applicants claims are drawn to biurets, and it is for this reason that the reference has been relied upon. Furthermore, a *prima facie* case of obviousness does not require the solution of the same problem or recognition of the same advantages as the applicants' invention. *In re Dillon*, 16 USPQ2nd 1897. Therefore, the lack of teaching concerning the reduction of viscosity does not cause the rejection to fail.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
July 13, 2003


RABON SERGENT
PRIMARY EXAMINER